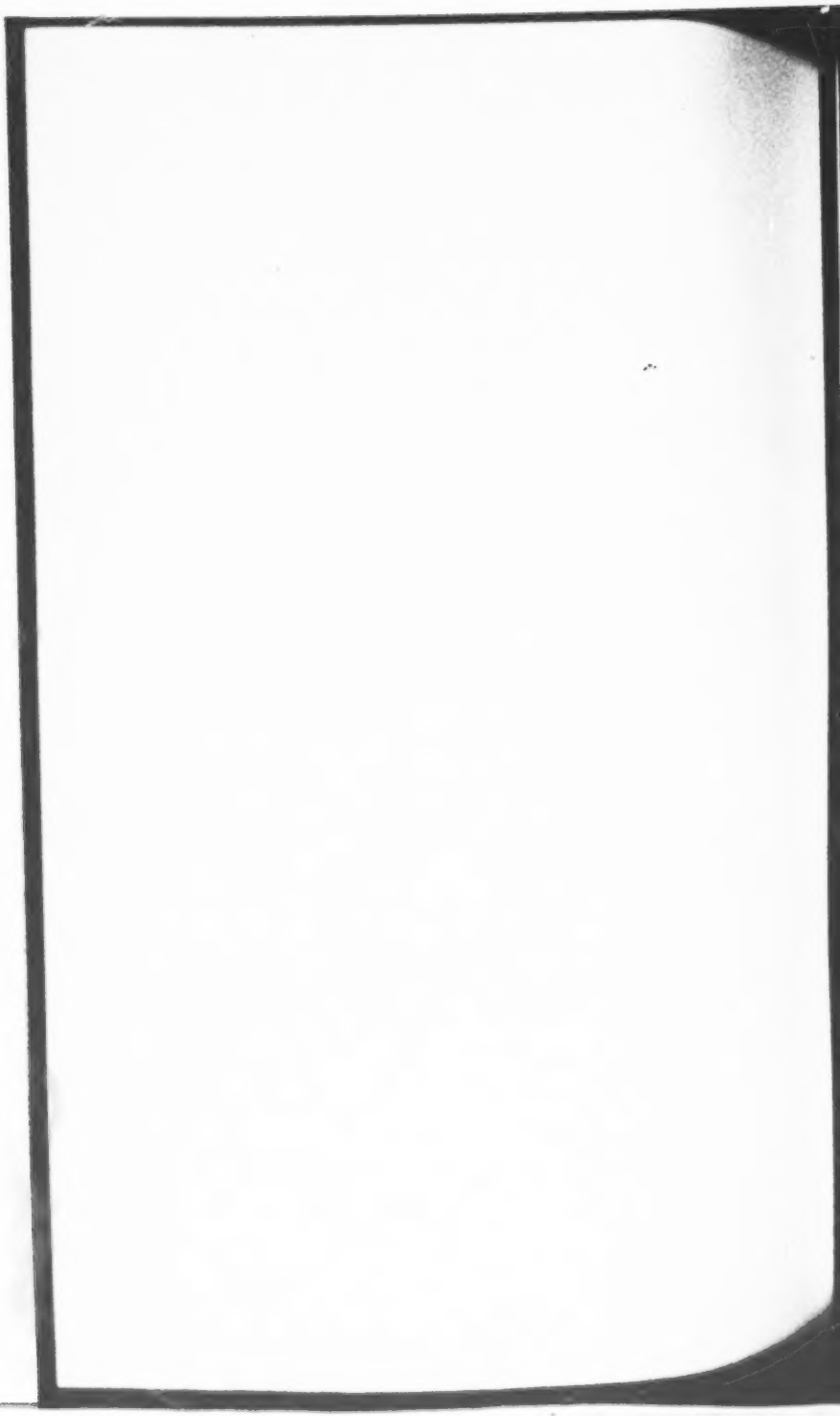


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IN THE

Supreme Court of the United States

OCTOBER TERM, 1970.

No. 338.

BLONDER-TONGUE LABORATORIES, INC.,
Petitioner,

vs.

UNIVERSITY OF ILLINOIS FOUNDATION,

AND

JFD ELECTRONICS CORPORATION,
Respondents.

REPLY OF RESPONDENT UNIVERSITY OF ILLINOIS FOUNDATION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

Respondent University of Illinois Foundation submits that the petitioner's statement of the issues in this case omits significant matters and is in certain respects slanted and argumentative. We therefore respectfully present the following comments for the Court's consideration.

JURISDICTION.

We do not contest the jurisdiction of this Court. We further recognize that there exists in this case a factor (diversity of opinion among two Courts of Appeals respecting the validity of a patent) which has sometimes, but not always[1], served as sufficient basis for this Court to exercise its jurisdiction and to grant a writ of certiorari. In this particular case, we submit that, in view of the different records on which each Court of Appeals based its decision, there is no actual conflict and that the case does not present any question of law of sufficient importance to justify review by this Court.

QUESTIONS PRESENTED.

The only question of sufficient importance to warrant possible consideration by this Court is Question I, relating to the conflict in the decisions of the Courts of Appeals. Petitioner has improperly designated Question I by including the allegation that the Isbell patent purports "to dominate the present day home television receiving antenna field". There is no support in the record for such an allegation.

Question II has no relationship to the conflict of decision between the Courts of Appeals on which petitioner has principally relied as a basis for asking this Court to exercise its jurisdiction. The patent alleged by petitioner to have been obtained by "misconduct in the Patent Office" is not the Isbell patent with respect to which the opinions

1. A recent example of this Court's refusal to grant certiorari in a patent case involving a conflict in the decisions of two Courts of Appeals respecting the validity of a patent occurred in *National Sponge Cushion Co.* v. *Allen Industries, Inc.*, No. 1012, October Term 1968.

of the Courts of Appeals differ. The patent to which petitioner refers, Mayes et al. Re. 25,740, was found invalid solely on the ground of obviousness by the Court of Appeals. The Foundation has accepted the decision of the Court of Appeals and has made no further effort to enforce this patent.

Question III seeks to create an issue where none properly exists within the context of this case. The alleged deficiency in the findings alluded to by petitioner refers to the findings of the District Court and not those of the Court of Appeals to which certiorari is directed. Petitioner does not allege that the findings of the Court of Appeals for the Seventh Circuit contained the same deficiency.

STATEMENT OF THE CASE.

Petitioner's statement of the case is replete with allegations having no relationship whatsoever even to petitioner's version of the question legitimately presented by this case. In our view, the only question of sufficient importance for this Court to consider is the validity of the Isbell patent. We will therefore direct our remarks primarily to those portions of petitioner's statement having relevance to this issue.

Question I.

It should be noted that the issue of the validity of the Isbell patent was once previously presented to this Court in a petition for a writ of certiorari filed by respondent Foundation in early 1969 (*University of Illinois Foundation* v. *Winegard Company*, October Term, 1968, No. 993). In that petition, respondent Foundation sought review of the decision of the Court of Appeals for the Eighth Circuit which held the Isbell patent invalid, in view of the conflicting decision of the District Court for the Northern District

of Illinois which had held the patent valid after consideration of the decision of the trial court in the Eighth Circuit. The decision of the Illinois District Court was then on appeal to the Seventh Circuit Court of Appeals. The Foundation's petition for a writ of certiorari was denied by this Court on March 24, 1969.[1]

Petitioner's allegation that there exists a conflict in the standard for obviousness which was applied by the Courts of Appeals for the Seventh and Eighth Circuits is erroneous. The standard applied was the same in both cases. The Court of Appeals for the Eighth Circuit should have found nonobviousness on the basis of the record, but at any rate the Court of Appeals for the Seventh Circuit had a different record to consider on this point and came to a different conclusion. Accordingly, although review by this Court would settle the immediate issue of whether the Isbell patent is valid over the cited prior art, no broadly applicable principle of law is involved in this petition.

The Court of Appeals for the Eighth Circuit, while admitting that Isbell's result was unpredictable, nevertheless held that it might be achieved by trial-and-error and was therefore obvious, even though, on the record, a random trial of all possibilities might have taken almost infinite amounts of time and money, since it was admitted that there were no guide posts which could be followed to arrive at the relatively few operative antennas among the countless number which would not work as desired. The Court quoted this Court's decision in *Graham* v. *John Deere Co.*, 383 U. S. 1, 17, as saying the test of nonobviousness is "one of inquiry, not quality."

Respondent's position in its petition for certiorari to the Court of Appeals for the Eighth Circuit was that if

1. A petition for out-of-time rehearing was recently filed by the Foundation.

something is unpredictable it cannot be said to be obvious. We acknowledge that obviousness does not require absolute predictability, as in a situation where only a few alternatives exist, in which it might be obvious to try them all just to see what would happen. In this particular case, however, there were countless possibilities and no guide posts to direct a researcher to one rather than another. The record showed that the great majority of the possibilities would fail. To use an analogy from another field, there are millions of stars and probably millions of solar systems in the universe. Many authorities believe that advanced life must exist on some of them. There are, however, no guide posts which can be used to point out those systems which support an advanced level of life as we know it. Since a trial-and-error approach could be used on this problem, identification of those systems having life by a modern day Columbus would appear obvious, following the rule applied by the Eighth Circuit Court of Appeals.

In its petition for a writ of certiorari, respondent took the position that there was a divergence between the principles applied by the Court of Appeals for the Eighth Circuit and those set out by this Court in *Graham* v. *John Deere Co.* for determining obviousness. However, this Court refused to grant the writ.

Realizing that denial of a petition for a writ of certiorari does not necessarily constitute approval of the decision of the lower court, respondent was careful to improve the record in the Seventh Circuit case by including the testimony of Dr. DuHamel, an expert in the specific phase of the antenna art encompassing Isbell's invention (*i.e.*, the log periodic field) and an author of the publication which was primarily relied upon by the Court of Appeals for the Eighth Circuit to support its finding of obviousness. Dr. DuHamel testified that the Isbell development was not obvious to him and that when he first heard of Isbell's invention he was surprised that it worked.

The record is therefore different in the two cases on the very point which was basic to the decision of the Court of Appeals for the Eighth Circuit. While respondent still regards the difference between "unpredictable" and "non-obvious" as being purely semantic, whatever difference may exist was emphasized in the Blonder-Tongue case.

Petitioner's argument that unless this petition is granted, the Isbell patent will be valid in one part of the United States and not in another is wholly specious. It erroneously assumes, in the first place, that if the petition is granted the patent will be held invalid. If the petition is granted and the patent is upheld, as it should be on the record, then the patent will be valid in the Seventh Circuit, but there will continue to be a decision against it in the Eighth Circuit. And, secondly, it assumes that it would be impossible to obtain a new decision in the Eighth Circuit upholding the patent on the same record as is here presented.

Question II.

Only two comments regarding Question II are necessary. First, the Court of Appeals for the Eighth Circuit did not find that the Mayes et al. patent was procured by fraud or wrong-doing. It held the patent invalid solely on the ground of obviousness.

Secondly, the Isbell patent and the Mayes et al. patent provided respondent Foundation with separate and independent causes of action against Blonder-Tongue. Even if some wrong-doing respecting the Mayes patent had been found, this would not serve as a basis for holding the Isbell patent invalid. *Keystone Driller Co.* v. *General Excavator Co.*, 290 U. S. 240, 245.

Question III.

Regardless of the degree of particularity with which the District Court set out its findings regarding Blonder-Tongue's patent, the Court of Appeals found sufficient basis in the record to affirm the lower court's decision. Any error which existed in the trial court's decision was harmless.

CONCLUSION.

For the above reasons, we do not believe this petition to present questions of sufficient importance to warrant further review. If the writ is granted, however, we submit that it should be limited to the issue of the validity of the Isbell patent, and request that the Court grant respondent a rehearing of its petition for a writ of certiorari in the Eighth Circuit case.

Respectfully submitted,

CHARLES J. MERRIAM,
WILLIAM A. MARSHALL,
BASIL P. MANN,
Counsel for Respondent, University of Illinois Foundation.

Of Counsel:
MERRIAM, MARSHALL, SHAPIRO & KLOSE,
30 West Monroe Street,
Chicago, Illinois 60603.